

REMARKS

I. Status of the Claims

Claims 15, 16, 18-22, and 26-33 are currently pending in this application. Claims 1-14, 17, and 23-25 have been canceled. New claims 29-33 have been added. Claims 15 and 16 have been amended. Support for amended claims 15 and 16 can be found, for example, on page 17, lines 10-19 and page 82, lines 4-6 of the as-filed specification and, for example, in original claims 1, 8, 10, and, respectively, 15 and 16. Support for new claim 30 can be found, for example, in original claim 17, and in the as-filed specification on page 18, lines 3-6, and in examples 21 to 31. Further, new claim 33 is supported, for example, on page 58, lines 8-11, and page 79, lines 6-10, of the as-filed specification. No new matter is presented in this Amendment.

II. Rejection Under 35 U.S.C. § 103

As set forth in the Office Action dated April 30, 2004, claims 15, 16, 18-22, and 26-28 were rejected under 35 U.S.C. 103(a) as allegedly unpatentable over U.S. Patent No. 6,512,562 to *Kobayashi* in view of U.S. Patent No. 4,023,977 to *Mercurio*. For a 40 micron thick cellulose ester film of *Kobayashi*, the Examiner contends that the claimed moisture vapor transmittance and rate of mass change are either inherent or the result of routine experimentation. (April 30, 2004 Office Action, page 4.) Neither *Kobayashi* nor *Mercurio*, either alone or in combination, however, disclose or suggest the claimed invention. Thus, Applicants respectfully disagree with and traverse this rejection for at least the reasons of record and the following reasons.

Kobayashi discloses plasticizers, for example, triphenyl phosphate (see column 19, line 33) or ethylphthalylethyl glycolate (see column 19, line 41), which are preferably incorporated in the cellulose ester film. However, when a cellulose ester film with a thickness of 40 microns contains, as a plasticizer, triphenyl phosphate or ethylphthalylethyl glycolate, it does not provide the claimed rate of mass change. This is apparent from, for example, Table 1 (page 100) of the as-filed specification, which shows comparative Film Sample No. 12 (having a thickness of 40 microns and containing triphenyl phosphate) and comparative Film Sample No. 13 (having a thickness of 40 microns and containing ethylphthalylethyl glycolate). The rate of mass change (corresponding to retention property in Table 1) for comparative Film Sample Nos. 12 and 13 is outside the claimed scope. Thus, the claimed rate of mass change is not inherent for the 40 micron thick samples (Sample Nos. 12 and 13), and likewise cannot be said to be inherent for the 40 micron thick cellulose ester film of *Kobayashi*. Further, *Kobayashi* is silent on the rate of mass change of its cellulose ester film, and is silent as to the claimed rate of mass change of not more than 2 % of the cellulose ester film. The claimed rate of mass change cannot be said to be the result of routine experimentation, when *Kobayashi* itself is deficient on this point and when no guidance is provided on the parameters of such experimentation.

In view of the above, the rate of mass change as claimed is neither inherent nor the result of routine experimentation for a 40 micron thick cellulose ester film of *Kobayashi*. Thus, claims 15, 16, 18-22, and 26-28 are not obvious in light of the cited reference combination. To the contrary, the Examiner's contentions are based on

improper hindsight gleaned from the results of Applicants' invention. Accordingly, Applicants respectfully request withdrawal of the rejection under 35 U.S.C. §103.

III. Conclusion

In view of the foregoing Amendment and Reply, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

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